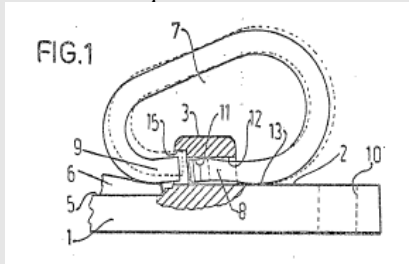


**European Court of Justice, 15 November 1983,
Duijnstee v Goderbauer**

Dutch patent # 7503503



INTERNATIONAL JURISDICTION

Court has to declare on its own motion that it has no jurisdiction in case of exclusive jurisdiction under article 16 of the Brussels Convention

- the reply to the first question must therefore be that article 19 of the Convention requires the national court to declare of its own motion that it has no jurisdiction whenever it finds that a court of another contracting state has exclusive jurisdiction under article 16 of the Convention, even in an appeal in cassation where the national rules of procedure limit the court's review to the grounds raised by the parties

Independent concept article 16 Brussels Convention

- the term "proceedings concerned with the registration or validity of patents" contained in article 16 (4) must be regarded as an independent concept intended to have uniform application in all the contracting states.

- Proceedings relating to rights of ownership of a patent are not "proceedings concerned with the registration or validity of patents"

the term "proceedings concerned with the registration or validity of patents" does not include a dispute between an employee for whose invention a patent has been applied for or obtained and his employer, where the dispute relates to their respective rights in that patent arising out of the contract of employment

Source: [Eur-lex](#)

European Court of Justice, 15 november 1983

(Mertens de Wilmars, Koopmans, Bahlman, O'Keefe, Bosco)

In case 288/82

Reference to the court under the protocol of 31 june 1971 on the interpretation by the court of justice of the Convention of 27 september 1968 on jurisdiction and the enforcement of judgments in civil and commercial matters from the Hoge Raad der Nederlanden (Supreme Court of The Netherlands) for a preliminary ruling in the appeal in cassation pending before that court between

Ferdinand m. J. J. Duijnstee, liquidator in the winding-up of BV Schroefboutenfabriek,

and

[...] Goderbauer,

Grounds

1 by a judgment of 29 october 1982, which was received at the court registry on 3 november 1982, the Hoge Raad der Nederlanden (Supreme Court of The Netherlands) referred to the court, for a preliminary ruling under the protocol of 3 june 1971 on the interpretation by the court of justice of the Convention of 27 september 1968 on jurisdiction and the enforcement of judgments in civil and commercial matters (hereinafter referred to as "the Convention"), three questions on the interpretation of articles 16 (4) and 19 of the Convention.

2 those questions arose in an appeal in cassation by Ferdinand m. J. J. Duijnstee against a judgment delivered on 20 may 1981 by the gerechtshof (regional court of appeal), ' s-Hertogenbosch, confirming a judgment of the arrondissementsrechtbank (district court), maastricht.

3 on 28 november 1979, mr Duijnstee had, in his capacity as the liquidator in the winding-up of bv schroefboutenfabriek, applied to the arrondissementsrechtbank, maastricht, for an interlocutory injunction requiring [...] Goderbauer, the former manager of that company, to transfer to it the patents applied for or granted in 22 countries, including some which have acceded to the Convention, in respect of an invention which mr Goderbauer had made while employed by that company. Mr Duijnstee's claim, which was based on the fact that the netherlands patent office had decided that bv schroefboutenfabriek was entitled to the netherlands patent for mr Goderbauer ' s invention, was dismissed on 19 december 1979.

4 on 21 december 1979, mr Goderbauer in turn brought an action against the liquidator in the arrondissementsrechtbank, maastricht, claiming that, if and in so far as the patents and applications for patents referred to in the writ were the property of the insolvent company, mr Goderbauer had a lien over them as against the liquidator. Mr Duijnstee then pleaded a counterclaim in the same terms as his application for an interlocutory injunction of 28 november 1979.

5 by judgment of 24 april 1980, the arrondissementsrechtbank, maastricht, dismissed both mr Goderbauer ' s claim and mr Duijnstee ' s counterclaim. That judgment was confirmed on appeal by the gerechtshof, ' s-hertogenbosch, by judgment of 20 may 1981.

6 mr Duijnstee appealed against that judgment to the hoge raad on the ground that it was contrary to the octrooiwet (netherlands patents law).

7 although the only ground of appeal was the alleged infringement of the netherlands patents law, the hoge raad none the less expressed doubt over its own jurisdiction on the ground that certain factors involving the law of other states might, by virtue of article 16 (4) of the Convention, mean that the courts of other contracting states had exclusive jurisdiction.

8 in the first place, the hoge raad raised the question whether, on the assumption that the courts of another contracting state had exclusive jurisdiction, that jurisdiction should be recognized even though the point had not been pleaded by any of the parties. Article 419 (1) of the netherlands code of civil procedure provides that the hoge raad is to confine its consideration of the case” to the grounds on which the appeal is based”, whereas article 19 of the Convention provides that” where a court of a contracting state is seised of a claim which is principally concerned with a matter over which the courts of another contracting state have exclusive jurisdiction by virtue of article 16, it shall declare of its own motion that it has no jurisdiction”.

9 in its first question, the hoge raad therefore asks the court whether the obligation imposed by article 19 on the court of a contracting state to declare of its own motion that it has no jurisdiction implies that a provision such as article 419 (1) of the netherlands code of civil procedure has no effect, inasmuch as a court of cassation must include in its consideration of the case the question covered by article 19 and, if that question is answered in the affirmative, must quash the judgment appealed against, even if the question has not been raised in the grounds of appeal.

10 in order to reply to that question, it is necessary to consider the aims of the Convention.

11 according to the preamble to the Convention, the contracting states, anxious to” strengthen in the community the legal protection of persons therein established”, considered that it was necessary for that purpose” to determine the international jurisdiction of their courts, to facilitate recognition and to introduce an expeditious procedure for securing the enforcement of judgments, authentic instruments and court settlements”.

12 both the provisions on jurisdiction and those on the recognition and enforcement of judgments are therefore aimed at strengthening the legal protection of persons established in the community.

13 the principle of legal certainty in the community legal order and the aims pursued by the Convention in accordance with article 220 of the treaty, on which it is based, require that the equality and uniformity of rights and obligations arising from the Convention for the contracting states and the persons concerned must be ensured, regardless of the rules laid down in that regard in the laws of those states.

14 it must be concluded that the Convention, which seeks to determine the jurisdiction of the courts of the contracting states in civil matters, must override national provisions which are incompatible with it.

15 the reply to the first question must therefore be that article 19 of the Convention requires the national court to declare of its own motion that it has no jurisdiction whenever it finds that a court of another contracting state has exclusive jurisdiction under article 16 of the Convention, even in an appeal in cassation where the national rules of procedure limit the court ' s reviewal to the grounds raised by the parties.

16 in its second question the hoge raad asks whether the concept of proceedings” concerned with the registration or validity of patents” within the meaning of article 16 (4) of the Convention, which attributes exclusive jurisdiction to the courts of the contracting state competent to grant the patent, must be defined on the basis of the law of the contracting state whose courts are referred to in that provision, or according to the *lex fori*, or on the basis of an independent interpretation of the said provision.

17 the court has several times had occasion to consider the criteria to be used for the definition of the concepts appearing in the Convention. Thus, in its judgment of 22 february 1979 in case 133/78 (*gourdain v nadler* (1979) ecr 743), it stated that” in order to ensure, as far as possible, that the rights and obligations which derive from (the Convention) for the contracting states and the persons to whom it applies are equal and uniform”, it is necessary that the terms of article 1 of the Convention should not be interpreted” as a mere reference to the internal law of one or other of the states concerned”, and” the concepts used in article 1 must be regarded as independent concepts which must be interpreted by reference, first, to the objectives and scheme of the Convention and, secondly, to the general principles which stem from the corpus of the national legal systems”. The court also stressed the need for an independent interpretation in its judgment of 21 june 1978 in case 150/77 (*bertrand v ott* (1978) ecr 1432), in relation to the terms used in article 13 and in the second paragraph of article 14 of the Convention, and in its judgment of 22 march 1983 in case 34/82 (*martin peters bauunternehmung v zuid nederlandse aannemers vereniging* (1983) ecr 987), in relation to the terms used in article 5 (1) of the Convention.

18 in the present case, both an interpretation according to the law of the contracting state whose courts have jurisdiction under article 16 (4) and an interpretation according to the *lex fori* would be liable to produce divergent solutions, which would be prejudicial to the principle that the rights and obligations which the persons concerned derive from the Convention should be equal and uniform.

19 thus the term” proceedings concerned with the registration or validity of patents” contained in article 16 (4) must be regarded as an independent concept intended to have uniform application in all the contracting states. 20 this reply to the second question compels the court to define the term” proceedings concerned with the registration or validity of patents”, since the hoge raad has asked in its third question whether that concept may cover a dispute such as that concerned in the main action.

21 in order to reply to the third question, reference must again be made to the objectives and scheme of the Convention.

22 in that regard, it must be noted that the exclusive jurisdiction in proceedings concerned with the registration or validity of patents conferred upon the courts of the contracting state in which the deposit or registration has been applied for is justified by the fact that those

courts are best placed to adjudicate upon cases in which the dispute itself concerns the validity of the patent or the existence of the deposit or registration.

23 on the other hand, as is expressly stated in the report on the Convention (official journal 1979, c 59, p. 1, at p. 36),” other actions, including those for infringement of patents, are governed by the general rules of the Convention”. That statement confirms the restrictive nature of the provision contained in article 16 (4).

24 it follows that proceedings” concerned with the registration or validity of patents” must be regarded as proceedings in which the conferring of exclusive jurisdiction on the courts of the place in which the patent was granted is justified in the light of the factors mentioned above, such as proceedings relating to the validity, existence or lapse of a patent or an alleged right of priority by reason of an earlier deposit.

25 if, on the other hand, the dispute does not itself concern the validity of the patent or the existence of the deposit or registration, there is no special reason to confer exclusive jurisdiction on the courts of the contracting state in which the patent was applied for or granted and consequently such a dispute is not covered by article 16 (4).

26 in a case such as the present, neither the validity of the patents nor the legality of their registration in the various countries is disputed by the parties to the main action. The outcome of the case in fact depends exclusively on the question whether mr Goderbauer or the insolvent company bv schroefboutenfabriek is entitled to the patent, which must be determined on the basis of the legal relationship which existed between the parties concerned. Therefore the special jurisdiction rule contained in article 16 (4) should not be applied.

27 in that regard, it should be pointed out that a very clear distinction between jurisdiction in disputes concerning the right to the patent, especially where the patent concerns the invention of an employee, and jurisdiction in disputes concerning the registration or validity of a patent was made both in the european patent Convention signed in munich on 5 october 1973 and in the community patent convention signed in luxembourg on 15 december 1975 (official journal 1976, l 17), which has not yet entered into force. Although those two Conventions are not applicable in this case, the fact that they expressly accept such a distinction confirms the interpretation given by the court to the corresponding provisions of the brussels Convention.

28 the reply to the third question should therefore be that the term” proceedings concerned with the registration or validity of patents” does not include a dispute between an employee for whose invention a patent has been applied for or obtained and his employer, where the dispute relates to their respective rights in that patent arising out of the contract of employment.

Costs

29 the costs incurred by the governments of the federal republic of germany and the united kingdom and by the commission of the european communities, which have submitted observations to the court, are not recoverable. As these proceedings are, in so far as the parties

to the main proceedings are concerned, in the nature of a step in the action before the national court, costs are a matter for that court.

On those grounds,

The court (fourth chamber),

In answer to the questions submitted to it by the Hoge Raad der Nederlanden by judgment of 29 october 1982, hereby rules :

1. Article 19 of the Convention requires the national court to declare of its own motion that it has no jurisdiction whenever it finds that a court of another contracting state has exclusive jurisdiction under article 16 of the Convention, even in an appeal in cassation where the national rules of procedure limit the court ' s reviewal to the grounds raised by the parties.

2.the term “proceedings concerned with the registration or validity of patents” contained in article 16 (4) must be regarded as an independent concept intended to have uniform application in all the contracting states.

3. the term “proceedings concerned with the registration or validity of patents” does not include a dispute between an employee for whose invention a patent has been applied for or obtained and his employer, where the dispute relates to their respective rights in that patent arising out of the contract of employment.